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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,029	07/26/2000	PETER HIMMELSBACH	BEIERSDORF-6	5165

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EXAMINER	
PIERCE, JEREMY R	
ART UNIT	PAPER NUMBER

1771
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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/601,029	HIMMELSBACH ET AL.	
	Examiner	Art Unit	
	Jeremy R. Pierce	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Objections

2. Claims 17-20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 17-20 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 cites the limitation of yarns having ultimate tensile stress strength of at least 10 N/cm. Claim 2 cites the limitation of the backing material having ultimate test

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strength of at least 10 N/cm. *Ex parte Slob*, 157 USPQ 172, states the following with regard to an article claimed by defining property values:

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics.

The ultimate tensile strength of yarns or the backing fabric is only a physical characteristic desired in the article. Claims 1 and 2 and the claims dependent upon claim 1 fail to set forth specific structures or compositions that would meet the desired physical characteristics set forth in the claim. This rejection also applies to other physical characteristics claimed without setting forth specific structures or compositions. These characteristics include the compression force cited in claim 4, the yarn strength cited in claim 6, and the dynamic-complex glass transition temperature at a frequency of 0.1 rad/s cited in claim 10.

6. Regarding claim 1, the word "means" is preceded by the word "overstitched" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Claims 3-20 are included in the rejection because of their dependence upon claim 1.

7. Claims 1 and 2 cite nonwoven material that is fully or partially coated with a doped adhesive composition. However, it is unclear what the Applicant wants to dope the adhesive with. Since it is not fully disclosed what the doping material is, the Examiner will assume the doping material is anything that is normally added to an

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adhesive to adjust a property of the adhesive, such as organic or inorganic filler, additives, etc.

8. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation "at least 3/cm", and the claim also recites "from 5 to 50/cm", which is the narrower statement of the range/limitation. Claim 5 recites the broad recitation "up to 500 g/m²", and the claim also recites "from 10 to 350 g/m²", which is the narrower statement of the range/limitation. Claim 8 recites the broad recitation "from 0.01 to 60% by weight", and the claim also recites "from 0.1 to 20% by weight", which is the narrower statement of the range/limitation. Claim 10 recites the broadest recitation "less than 15°C", the broader recitation "from 3°C to -30°C", and the narrow recitation "-3°C to -25°C". Claim

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15 recites the broadest recitation "greater than 15 g/m²", the broader recitation "between 90 g/m² and 500 g/m²", and the narrow recitation "between 130 g/m² and 500 g/m²".

9. Claim 8 recites the limitation "releasable active substance or substances" in the adhesive. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4, 7, 9, 10, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Riedel (U.S. Patent No. 4,967,740).

Riedel discloses a moisture vapor permeable tape for use on mammalian skin (column 1, lines 8-12). The backing material can be nonwoven and particularly a stitch-bonded fabric (column 3, lines 40-59). Riedel discloses that the preferred backing exhibits a desired combination of inherent properties such as moisture vapor permeability, softness, yield modulus, and strength. The tensile strength cited by the Applicant in claims 1 and 2 would be inherent to the material disclosed by Riedel because the materials, such as polyester (column 3, line 61) formed in a stitch-bonded fashion would create similar backing material described by the Applicant. The pressure sensitive adhesive can be a variety of materials, which are further used with primers, tackifiers and other additives (column 6, lines 13-25). With regard to claim 4, the

compression force value cited by the Applicant would be inherent to the material disclosed by Riedel since the structural and compositional limitations have been met. With regard to claim 7, the tear property cited by the Applicant would be inherent to the material disclosed by Riedel since the structural and compositional limitations have been met. With regard to claim 10, the glass transition temperature values for the adhesive composition cited by the Applicant would be inherent to the material disclosed by Riedel since the structural and compositional limitations have been met. With regard to claim 16, although not specifically mentioned, the material disclosed by Riedel is capable of being sterilized by gamma radiation.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-10, 12, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganschow (U.S. Patent No. 5,629,078) in view of Merkle et al. (U.S. Patent No. 5,527,536).

Ganschow discloses a back-coated adhesive tape based on a stitch-bonded web (column 1, lines 1-8). The tensile strength cited by the Applicant in claims 1 and 2 would be inherent to the material disclosed by Ganschow because the materials, such as polyester (column 1, line 54) formed in a stitch-bonded fashion would create similar

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backing material described by the Applicant. Ganschow does not teach the use of a doped adhesive. Merkle et al. disclose a patch material with a backing layer and an adhesive layer (column 1, lines 10-28). Merkle et al. teach that an active ingredient may be incorporated into the pressure-sensitive adhesive layer that contacts human skin. Both Ganschow and Merkle et al. disclose a material with a backing layer and an adhesive layer for contacting human skin. It would have been obvious to one skilled in the art to incorporate active ingredients into the adhesive layer of the medical tape provided by Ganschow in order to provide an improved medical tape with the increased capabilities provided by the active ingredient. With regard to claim 2, it would have been obvious to one skilled in the art to reinforce the web material by the formation of stitches formed by the loops from the fibers of the web in order to increase the strength of the backing layer. With regard to claim 3, Ganschow does not specifically disclose the number of stitches per centimeter of the stitch-bonded web. It would have been obvious to one skilled in the art to use at least 3 stitches per centimeter in order to provide a backing layer with the appropriate strength in the use as a tape. With regard to claim 4, the compression force value cited by the Applicant would be inherent to the material disclosed by Ganschow since the structural and compositional limitations have been met. With regard to claim 5, Ganschow discloses a backing layer with a basis weight of 100 g/m^2 (column 2, lines 17-18). With regard to claim 6, if not already inherent to the stitch-bonded web disclosed by Ganschow, it would have been obvious to one skilled in the art to use reinforcing yarns with a strength of at least 40 cN/tex in order to provide sufficient strength to the backing layer. With regard to claim 7, the tear

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property cited by the Applicant would be inherent to the material disclosed by Ganschow since the structural and compositional limitations have been met. With regard to claim 8, Merkle et al. disclose the active substance to be present in the adhesive in the amount of 2.5 to 25% by weight (Abstract). With regard to claim 10, the glass transition temperature values for the adhesive composition cited by the Applicant would be inherent in the adhesive disclosed by Merkle et al. since the structural and compositional limitations have been met. With regard to claims 12 and 13, Ganschow discloses the application of the adhesive by various processes, including screen printing and spraying (column 2, lines 4-11). With regard to claim 15, Ganschow does not disclose the amount of adhesive applied to the backing material. It would have been obvious to one skilled in the art to apply at least 15 g/m² of adhesive to the backing layer in order to create a tape material with sufficient adhesive to adhere to the human skin. With regard to claim 16, the tape material disclosed by the combination of the Ganschow reference with the Merkle et al. reference is capable of being sterilized by gamma radiation.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ganschow in view of Merkle et al. as applied to claim 1 above, and further in view of Bredahl et al. (U.S. Patent No. 5,539,033).

Ganschow and Merkle et al. fail to disclose foaming the adhesive layer prior to application to the backing layer. Bredahl et al. teach a process for making pressure sensitive adhesive tape, including medical tapes (column 9, lines 43-50). Bredahl et al. disclose the adhesive layer can be foamed (column 8, lines 58-65). It would have been

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obvious to one skilled in the art to foam the adhesive prior to applying to the backing layer in order to increase the air permeability of the adhesive.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ganschow in view of Merkle et al. as applied to claim 1 above, and further in view of Crawley et al. (U.S. Patent No. 5,948,707).

Ganschow discloses applying the adhesive to the backing layer by means of screen printing, but does not specifically state that the adhesive will be in the form of polygeometric domes. Crawley et al. disclose a non-slip waterproof fabric (Abstract). Via screen printing, Crawley adds a layer of elastomeric material in the forms of dome-like projections to the fabric that gives the fabric a gripping capability when contacted with skin (column 7, lines 5-45). It would have been obvious to one skilled in the art to put the adhesive layer in the form polygeometric domes in the tape taught by the combination of Ganschow and Merkle et al. in order to make a tape that did not adhere too strongly to the human skin.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

0661.



Jeremy R. Pierce
Examiner

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February 25, 2002



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